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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,091	01/22/2002	Eiichi Kito	1259-0221P	3458

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/051,091	Applicant(s) KITO, EIICHI	
	Examiner Matthew S. Gart	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History Summary

Claims 1-22 are present in this application. Claims 1, 8, 17 and 22 are independent. Claim 22 is new.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski (U.S. Patent Application Publication 2005/0182649) in view of Fredlund et al. (U.S. Patent No. 5,666,215).

Referring to claim 1. Parulski discloses an order accepting method, said method comprising the steps of:

- Indicating a menu image in a display panel for inputting ordering information to specify an order placed for a service provided by an associate (Parulski: paragraph 0007, "...a service provider providing a menu identifying a plurality of different photo services that can be selected by a user.");
- Determining said order information in response to an input signal according to said menu image (Parulski: paragraph 0008, "...the service provider establishing a user service account containing data identifying a photo service selected by the user from the menu.");
- Wherein said menu image includes:
 - A service-selecting region for selecting one of plural services different from one another (Parulski: "In block 106, the fulfillment center 40 provides the customer with a menu of photo products 66 that are available

for customization and purchase, such as standard service prints, framed hardcopy prints as depicted in FIG. 3, and customized photo albums as depicted in FIG. 4.”); and

- o A conditioning item setting region for retrieving a conditioning application according to said selected service, the conditioning application including a menu of selectable conditioning items and visual controls for setting a selected conditioning item for the common item (Parulski: “In block 110, the network server 42 provides a menu of customizable features for the type of product selected by the user. This menu is displayed on display monitor 14 if the user is located at the home computer system 10, or on touch screen display 84 if the user is located at retail kiosk 80.”)

Parulski does not expressly disclose a menu image comprising plural regions for setting plural items included in said ordering information, said plural regions including at least a common item specifying region for specifying a common item common between said services, wherein said common item remains specified while the menu image is changed from displaying one service to a different service upon selection of the different service.

Fredlund discloses a menu image (Fredlund: Fig. 3, “50”) comprising plural regions for setting plural items included in said ordering information, said plural regions including at least a common item specifying region for specifying a common item common between said services (Fredlund: Fig. 3 “52”), wherein said common item

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remains specified while the menu image is changed from displaying one service to a different service upon selection of the different service (Fredlund: column 5, lines 32-51).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Parulski to have included the teachings of Fredlund as discussed above in order to have an improved system and method for facilitating ordering and re-ordering of prints and other image related services (Fredlund: column 2, lines 11-19).

Referring to claim 2. Parulski further discloses a method wherein said plural services are provided by plural associates (Parulski: Fig. 1B: "60, 56, 58, 68 and 64").

Referring to claim 3. Parulski further discloses a method wherein said plural services are printing services for printing an image (Parulski: Fig. 1B: "58").

Referring to claim 4. Parulski further discloses a method wherein said ordering information is sent to one of said associates through a communication line, and said one associate is combined with a selected one of said plural services according to said ordering information (Parulski: paragraph 0002).

Referring to claim 5. Parulski further discloses a method wherein said conditioning item setting region is preset individually between said plural associates (Parulski: Fig. 1B: "**60, 56, 58, 68 and 64**").

Referring to claim 6. Parulski further discloses a method wherein said conditioning item includes information of a product type of a product according to said service, layout information of said image in said product, and/or information of an amount and/or cost of said product, and wherein said layout information includes information of a size of said product, disposition of said image, and/or a size of said image (Parulski: Fig. 5).

Referring to claim 7. Parulski further discloses a method wherein said plural services include at least one of a service of developing photo film and printing said image, a reprinting service of said image, a printing service according to a template layout of plural images (Parulski: Fig. 1A: "**132, 134 and 136**"), an enlarging printing service of said image, a producing service of a booklet of plural images, a printing service of said image to a sheet, and a printing service of said image to an article (Parulski: Fig. 5).

Referring to claims 8-16. Claims 8-16 are rejected under the same rationale as set forth above in claims 1-7.

The Examiner notes (with reference to claim 14), neither Parulski nor Fredlund expressly disclose an order accepting apparatus as defined in claim 11, wherein said service selecting region and said conditioning item setting region are arranged horizontally to one another.

The Examiner notes, shifting the menu regions does not modify the operation of Parulski's invention. To have modified Parulski to have included various menu region arrangements would have been obvious to the skilled artisan because the inclusion of such step would have been an obvious matter of design choice in light of the method already disclosed by Parulski. Such modification would not have otherwise affected Parulski and would have merely represented one of numerous steps that the skilled artisan would have found obvious for the purposes already disclosed by Parulski. Additionally, applicant has not persuasively demonstrated the criticality of providing this arrangement versus the arrangement disclosed in Parulski. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

The Examiner notes (with reference to claim 15), neither Parulski nor Fredlund expressly disclose an order accepting apparatus as defined in claim 11, wherein said common item specifying region is disposed under at least one of said service selecting region and said conditioning item setting region.

The Examiner notes, shifting the menu regions does not modify the operation of Parulski's invention. To have modified Parulski to have included various menu region arrangements would have been obvious to the skilled artisan because the inclusion of

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such step would have been an obvious matter of design choice in light of the method already disclosed by Parulski. Such modification would not have otherwise affected Parulski and would have merely represented one of numerous steps that the skilled artisan would have found obvious for the purposes already disclosed by Parulski.

Additionally, applicant has not persuasively demonstrated the criticality of providing this arrangement versus the arrangement disclosed in Parulski. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Referring to claims 17-21. Claims 17-21 are rejected under the same rationale as set forth above in claims 1-7.

Referring to claim 22. Claim 22 is rejected under the same rationale as set forth above in claims 1-7.

Response to Arguments

Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new grounds of rejection.

The Applicant argues that Parulski does not disclose plural associates for providing plural services.

The Examiner notes, Parulski discloses a method wherein the various portions of the fulfillment center **40** can be located in a single building or complex of adjacent buildings, or can be geographically disbursed over several sites in different cities or even different continents. For example, the electronic database **44** and the production controller **52** can be provided by computers located in different cities and interconnected via a suitable digital communications network, such as the Internet. Furthermore, the electronic database **44** can itself be distributed over several computers in several different locations.

The specification as originally filed defines an "associate" as an entity that provides different types of the services. In its broadest sense an associate could be construed as an associated printer, an associated server, or an associated location. The specification as originally filed is not limited to an associated business entity independently owned. During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification." In re Hyatt, 211 F.3d1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more

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broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-273-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MSG
Primary Examiner
September 27, 2006